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APPLICATION NO.	FILING DATE	FIRST-NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,322	11/20/2003	Armin Fehn	WAS 0612 PUS	1060
22045	7590	02/01/2005	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			ZIMMER, MARC S	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/718,322	FEHN, ARMIN	
	Examiner	Art Unit	
	Marc S. Zimmer	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 10-14 is/are rejected.
- 7) ☒ Claim(s) 3-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Objections

Claims 1-14 are objected to because the preamble of claim 1 clearly defines the invention as an organosilicon compound having alkynol moieties yet an embodiment is disclosed wherein "e", which denotes the number of residues containing said alkynol groups, may be zero. In this instance, the compound would obviously be devoid of alkynol groups in disagreement with the early characterization of the invention. Notably, in the absence of units adhering to formula III, there is nothing exceptional about the claimed compound whatsoever. Correction is required.

Claim Analysis

It is noted for the record that claims 10 to 14 are product-by-process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

It is the Examiner's position that these claims recite nothing more a molded product derived from a conventional hydrosilylation-cured silicone elastomer (containing reinforcing fillers and other adjuvants where mentioned). It is appreciated that, unlike the presently claimed molded material, the molded elastomers taught by the prior art will not contain a compound corresponding to component (C) and are, in that sense, distinct. However, they are, in the Examiner's opinion, not patentably distinct insofar as,

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in the molded product, component (C) represents nothing more than a residual impurity and, hence, is not a grounds for patentability. (Even claim 7 allows that (C) may constitute as little as 0.0001% by weight of the total.)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

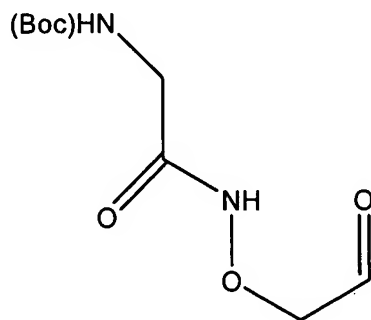
Claims 1 and 2 are rejected under 35 U.S.C. 102(a) as being anticipated by the article entitled, "Enantioselective Total Synthesis of Nicandrenones" authored by Corey et al. Compound 19 in Scheme 2 anticipates the claimed compound where "h" is zero, X = O, and R⁴ adjacent to the propargyl alcohol residue is a 2,3-dimethylbutenyl radical. (The shorthand notation "TBS" stands for tert-butyldimethylsilyl and is derived from the silylation of compound 15 with tert-butyldimethylsilane according to lines 1 and 2 beneath the scheme.)

Claims 1 and 2 are rejected under 35 U.S.C. 102(a) as being anticipated by the article entitled, "The Synthesis of Deoxyfusapyrone. 1. An Approach to the Pyrone

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Moiety" authored by Organ et al. Compound 13 in Scheme 2 anticipates the claimed compound where "h" is zero, X = O, and R⁴ adjacent to the propargyl alcohol residue is a 2,2-dimethylpropylene radical. TBS takes on the same meaning as it had in the previous case.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by the article entitled "Synthesis of 4-Vinyl Substituted β -Lactams of the Oxamazin Family" authored by Guanti et al. Compound 5 in Scheme 5 anticipates the claimed compound where the R⁴ residue adjacent the trimethylsilyl moiety is ethylene, X = O, and the R⁴ adjacent to the propargyl alcohol residue is



Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by the article entitled, "Enantioselective Formation of Functionalized 1,3-Disubstituted Allenes: Synthesis of α -allenic ω -Carbomethoxy Alcohols of High Optical Purity" authored by Gooding et al. Compound 5 of Scheme II anticipates the claimed compound where "h" is zero, X = O, and R⁴ adjacent to the propargyl alcohol residue is methylene. The designation TBDPS is shorthand for tert-butyldiphenylsilane and is introduced by silylating the corresponding alcohol with tert-butyldiphenylsilyl chloride.

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Applicant is advised that these are only a small sample of the multitude compounds disclosed in the art that adhere to the structural limitations of formula III of claim 1. In the name of brevity, no additional references will be cited at this time against the compound claims.

Claims 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Chiba et al., U.S. patent # 5,607,992. Chiba discloses a silicone rubber composition formulated for injection molding that comprises all of the materials delineated in the paragraph bridging columns 2 and 3 and also one or more of the adjuvants disclosed in column 6, lines 36-45. A molded product obtained upon curing the composition is not patentably distinct from that set forth in the aforementioned claims.

Claims 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Cowan, U.S. patent # 4,877,820. Cowan discloses the preparation of molded materials by crosslinking an organohydrogenpolysiloxane with polycyclic polyene in the presence of a catalyst (abstract). Additives including fillers (bottom of paragraph 4) and stabilizers/antioxidants (column 5, line 19) may be incorporated into the crosslinkable composition. A molded product obtained upon curing the composition is not patentably distinct from that set forth in the aforementioned claims.

Allowable Subject Matter

Claims 3-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (pending resolution of the matter outlined under the heading "Claim Objections").

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The prior art contains numerous examples of non-volatile catalyst inhibitors having siloxane oligomer backbones as a primary structural attribute (see, e.g. U.S. Patent Nos. 3,989,667 and 4,032,502). However, none of these have repeat units corresponding to formula III.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 29, 2005



Marc Zimmer
AU 1712